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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,938	08/21/2003	Hideki Sugiura	241828US0	7365
22850	7590	06/12/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,938

Applicant(s)

SUGIURA ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-6, 10-14 and 22 is/are allowed.
6) ☒ Claim(s) 15-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/11/05; 12/16/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. The examiner acknowledges the cancellation of claim 9 set forth in the amendment filed on Mar. 27, 2006. Claims 1-6 and 10-22 are pending.

The "Amendment to the specification" section set forth in the amendment filed on Jan. 6, 2006, has been entered.

2. The "Amendment to the claims" section filed on Jan. 6, 2006, does not comply with 37 CFR 1.121 for the reasons discussed in the "Notice of Non-compliant Amendment" mailed on Mar. 21, 2006. Accordingly, that "Amendment to the claims" section has not been entered.

3. The examiner has considered the US applications listed on "List of related cases" in the Information Disclosure statements filed on Oct. 11, 2005, and Dec. 16, 2005.

4. The rejection of claim 19 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Oct. 6, 2005, paragraph 10, has been withdrawn in response to the amendment to claim 19 set forth in the amendment filed on Mar. 27, 2006.

The rejection of claims 1-6 and 9-14 under 35 U.S.C. 102(b)/103(a) over US 2002/0081510 A1 (Sugiyama), as

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evidenced by applicants' admission I, set forth in the office action mailed on Oct. 6, 2005, paragraph 12, has been withdrawn in response to the amendment to independent claim 1 set forth in the amendment filed on Mar. 27, 2006, and in response to the showing in the Rule 132 declaration, which was executed by Hideki Sugiura on Dec. 20, 2005, filed on Jan. 6, 2006. That amendment to claim 1 added the limitation of now-cancelled claim 9 that "a ratio (S/V) of the surface concentration of nitrogen S [of the toner] to the overall concentration of nitrogen V [in the toner] is from 1.2 to 10." The Rule 132 declaration shows that the toner in example 14 of Sugiyama has a ratio (S/V) of 1.1, which is outside the scope of the S/V ratio of 1.2 to 10 recited in instant claim 1. Accordingly, for the reasons discussed by applicants in the response filed on Jan. 6, 2006, the toner recited in instant claims 1-6, 10-14, and 22 is neither anticipated by nor obvious over Sugiyama.

The rejections of claims 1-6, 9-14, and 22 under 35 U.S.C. 102(a)/103(a) over US 2003/0138717 A1 (Yagi), as evidenced by applicants' admission II, and of claims 1-6, 9-14, and 22 under 35 U.S.C. 102(e)/103(a), set forth in the office action mailed on Oct. 6, 2005, paragraph 15, have been withdrawn in response to the amendment to independent claim 1, as described supra, and in response to the showing in the Rule 132

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declaration filed on Jan. 6, 2006. The Rule 132 declaration shows that the toner in example 1 of Yagi has a ratio (S/V) of 1.1, which is outside the scope of the S/V ratio of 1.2 to 10 recited in instant claim 1. Accordingly, for the reasons discussed by applicants in the response filed on Jan. 6, 2006, the toner recited in instant claims 1-6, 10-14, and 22 is neither anticipated by nor obvious over Yagi.

The rejections of claims 1-6, 9-14, and 22 under 35 U.S.C. 102(a)/103(a) over US 2003/0104297 A1 (Matsuda), as evidenced by applicants' admission III, and of claims 1-6, 9-14, and 22 under 35 U.S.C. 102(e)/103(a) over Matsuda, as evidenced by applicants' admission III, set forth in the office action mailed on Oct. 6, 2005, paragraph 19, have been withdrawn in response to the amendment to independent claim 1, as described supra, and in response to the showing in the Rule 132 declaration filed on Jan. 6, 2006. The Rule 132 declaration shows that the toner in example 13 of Matsuda has a ratio (S/V) of 1.1, which is outside the scope of the S/V ratio of 1.2 to 10 recited in instant claim 1. Accordingly, for the reasons discussed by applicants in the response filed on Jan. 6, 2006, the toner recited in instant claims 1-6, 10-14, and 22 is neither anticipated by nor obvious over Matsuda.

5. The disclosure is objected to because of the following informalities:

The use of trademarks, e.g., Fluorad [sic: FLUORAD] at page 45, line 16, and Printex [sic: PRINTEX] in the amended paragraph beginning a page 81, line 5, of the specification, set forth in the amendment filed on Jan. 6, 2005, has been noted in this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. These examples are not exhaustive. Applicants should review the entire specification for compliance.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Applicants' arguments filed on Jan. 6, 2006, have been fully considered but they are not persuasive.

Applicants assert that the amendment to the specification filed on Jan. 6, 2006, overcomes the objection.

However, as discussed in the above objection, that amendment did not capitalize all the trademarks disclosed in the specification. Accordingly, the objection stands.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 15, 20, and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2002/0081510 A1 (Sugiyama), as evidenced by applicants' admission in example 1 at pages 82-83 and in Table 1 of the instant specification (applicants' admission I).

The claims are rejected for the reasons discussed in the office action mailed on Oct. 6, 2005, paragraph 12, which are incorporated herein by reference.

8. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/00118366 A1 (Nukada) combined with Sugiyama, as evidenced by applicants' admission I.

The claims are rejected for the reasons discussed in the office action mailed on Oct. 6, 2005, paragraph 13, which are incorporated herein by reference.

9. Claims 15-18, 20, and 21 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35

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U.S.C. 103(a) as obvious over US 2003/0138717 A1 (Yagi), as evidenced by applicants' admissions at page 11, line 19, to page 12, line 2, page 12, lines 14-23, and page 48, lines 10-20, and in example 1 at pages 82-83 and in Tables 1 and 2, of the instant specification (applicants' admission II).

Claims 15-18, 20, and 21 are rejected under 35 U.S.C. 102(e) as anticipated by Yagi, as evidenced by applicants' admission II.

The claims are rejected for the reasons discussed in the office action mailed on Oct. 6, 2005, paragraph 16, which are incorporated herein by reference.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nukada combined with Yagi, as evidenced by applicants' admission II.

The claims are rejected for the reasons discussed in the office action mailed on Oct. 6, 2005, paragraph 17, which are incorporated herein by reference.

Note that the header in the rejection in paragraph 17 inadvertently cited Sugiyama, rather than the reference Yagi, as evidenced by applicants' admission II. Yagi was discussed in the body of the rejection. Because applicants have addressed

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the rejection, it appears that applicants were aware of the use of the reference Yagi in the rejection.

11. Claims 15-18, 20, and 21 are rejected under 35

U.S.C. 102(a) as anticipated by or, in the alternative, under 35

U.S.C. 103(a) as obvious over US 2003/0104297 A1 (Matsuda), as evidenced by applicants' admissions at page 12, lines 14-23, and page 48, lines 10-20, and in example 1 at pages 82-83 and in Table 1, of the instant specification (applicants' admission III).

Claims 15-18, 20, and 21 are rejected under 35

U.S.C. 102(e) as anticipated by Matsuda, as evidenced by applicants' admission III.

The claims are rejected for the reasons discussed in the office action mailed on Oct. 6, 2005, paragraph 19, which are incorporated herein by reference.

Note that the body of the rejections in paragraph 19 inadvertently labeled the Matsuda toner as that of example 12, instead of example 13. The reference cites and the description of the method of making the toner in the rejections are clearly those of example 13. Because applicants' arguments are based on the toner in example 13 of Matsuda, it appears that applicants were aware that the Matsuda toner described in the rejections

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was the toner in example 13 of Matsuda.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nukada combined with Matsuda, as evidenced by applicants' admissions III.

The claims are rejected for the reasons discussed in the office action mailed on Oct. 6, 2005, paragraph 20, which are incorporated herein by reference.

13. Applicants' arguments filed on Jan. 6, 2006, regarding the rejections in paragraphs 7-12 above have been fully considered but they are not persuasive.

Applicants assert that none of the cited prior art toners exhibit a S/V ratio as recited in instant claim 1 as shown in the Rule 132 declaration filed on Jan. 6, 2006.

However, instant claims 15-21 recite the presence of a toner comprising a polyester resin containing nitrogen that "a concentration of nitrogen at the surface [of the toner] being more than a concentration of nitrogen in the entire toner." Instant claims 15-21 do not recite that that the toner has a ratio (S/V) of the surface concentration of nitrogen S of the toner to the overall concentration of nitrogen V of the toner of 1.2 to 10 as asserted by applicants. Applicants cannot argue

patentability based on limitations that are not present in the claims.

Moreover, the Rule 132 declaration shows that each of the Sugiyama toner, Yagi toner, and the Masuda toner, has a ratio S/V of 1.1. Thus, the prior art toners meet the limitation of "a concentration of nitrogen at the surface [of the toner] being more than a concentration of nitrogen in the entire toner" recited in instant claims 15-21. Moreover, applicants have not provided any objective evidence showing that the prior art toners do not have the other properties, i.e., the hardness, the heat resistance, or the cross-linking density recited in instant claims 15-21. Accordingly, the rejections of claims 15-21 over the cited prior art stand.

Applicants further assert that neither Yagi nor Matsuda qualify as prior art under 35 U.S.C. 103(c). Applicants state that Yagi, Matsuda, and the present application "were, at the time the invention of the present application was made, owned by Ricoh Co., Ltd."

However, as discussed in the office action mailed on Oct. 6, 2005, paragraphs 15 and 18, respectively, Yagi and Matsuda were published on Jul 24, 2003, and on Jun. 5, 2003, respectively. The inventive entities in Yagi and in Matsuda both differ from that of the instant specification. The

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publishing dates of Yagi and Matsuda are both prior to the instant application's US filing date of Aug. 21, 2003. Thus, both Yagi and Matsuda qualify as prior art under 35 U.S.C. 102(a) and under 35 U.S.C. 103(c). Therefore, the rejections under 35 U.S.C. 103(a) over Yagi in paragraphs 9 and 10 and the rejections under 35 U.S.C. 103(a) over Matsuda in paragraphs 11 and 12, stand.

14. Claims 1-6, 10-14, and 22 are allowable over the prior art for the reasons discussed in paragraph 4 above, which are incorporated herein by reference.

15. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L.

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Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (271) 273-8300.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Jun. 6, 2006

Janis L. Dote
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PRIMARY EXAMINER
GROUP 1522
1700